

Application No.: 09/682,074

REMARKS/ARGUMENTS

Applicants assert that no new matter is presented by these amendments and respectfully request entry of the same. In the present application, claims 1-36 are pending, and upon entry of the requested amendment claims 1-2, 4-9, 12-15, 18, 22-24, 27, 29, 32-36 will be pending and claims 3, 10-11, 16-17, 19-21, 25-26, 28, and 30-31 will be cancelled. Of these, claims 1, 18, 27, 35, and 36 are independent. Applicants also acknowledge with appreciation the Examiner's statement of allowable subject matter in claims 3-9, 12, 13, 19-24, 31, and 32.

Reply to Claim Rejections - 35 USC §102(e)

Claims 1, 14, 16, 17, 27, 28, 33, 35, and 36 are rejected under 35 USC 102(e) as being anticipated by Montagu (6,407,858).

Claim 1 has been amended to adopt the examiner's suggestion with respect to the allowable subject matter of Claim 3 that includes the step of providing a user interface that enables user selection of the location data; and accessing the location data based, at least in part upon the user selection. Although claim 1 as amended does not include providing an interface that enables user specification of the probe feature locations as stated in intervening claim 2, the applicants respectfully assert that such a limitation is not necessary for the patentability of amended claim 1. Montagu does not teach or suggest the combination of an interface that enables user selection of the location data, accessing the location data based, at least in part upon the user selection, and scanning the substrate based, at least in part, on the accessed location data. Further, such a

Application No.: 09/682,074

combination would not be inherent in the disclosure, and thus the combination does not need to rely on any further limitation to be patentable.

Claim 14 depends from and further limits Claim 1 that as amended applicants assert is patentable, thus applicants respectfully assert that Claim 14 is also patentable.

Claims 16 and 17 have been cancelled.

Claim 27 has been amended to adopt the examiners suggestion with respect to claim 31 of including a data retriever that receives the location data from a memory unit of a first computer and stores the location data in memory of a second computer. Claim 27 has also been amended to include the subject matter of intervening claim 30 of a data retriever that provides a user interface that enables a user selection of location data, and accesses the location data based, at least in part, on the user selection. Although claim 27 as amended does not include the first computer constructed and adapted to control an arrayer as stated in intervening claim 29, the applicants respectfully assert that such a limitation is not necessary for the patentability of amended claim 27. Montagu does not teach or suggest the combination of a data retriever that receives the location data from a memory unit of a first computer and stores the location data in memory of a second computer either alone or in combination with a data retriever that provides a user interface that enables a user selection of location data, and accesses the location data based, at least in part, on the user selection. Further, such a combination would not be inherent in the disclosure, and thus the combination does not need to rely on any further limitation to be patentable.

Claim 28 has been cancelled.

Application No.: 09/682,074

Claims 33 and 34 depend from and further limit Claim 27 that as amended applicants assert is patentable, thus applicants respectfully assert that Claims 33 and 34 are also patentable.

Claim 35 has been amended in a manner similar to that of claim 27, and is thus patentable for the same reasons.

Similarly, Claim 36 has been amended in a manner similar to that of Claim 1, and is thus patentable for the same reasons.

Reply to Claim Rejections – 35 USC §102(b)

Claims 18, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubbell et al. (US 5,856,101).

The applicants have amended Claim 18 to adopt the examiners suggestion with respect to Claims 19, 20, and 21 of including the limitations of a user-interface manager that enables the user specification of the probe-feature locations by specifying one or more distances between the probes, one or more patterns of the probe locations, and by specifying coordinates. As the examiner suggests, the combination of Claim 18 as amended is not taught or suggested by the prior art and is thus patentable.

Claims 25 and 26 have been cancelled.

Application No.: 09/682,074

Reply to Claim Rejections – 35 USC §103(a)

Claims 2, 10, 11, 15, 29, 30, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montagu (6,407,858) in view of Hubbell et al. (5,856,101).

Applicants respectfully assert that at the time the invention of the present application was made, the Montagu (6,407,858) reference was commonly owned by Affymetrix, Inc. and as such may not be used as reference under 102(e)/103 as per section 103(c).

35 U.S.C. §103

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

At the time the invention was made Genetic Microsystems, Inc., the assignee of Montagu (6,407,858), was a wholly owned subsidiary of Affymetrix, Inc. as per a Merger agreement, titled "Affymetrix, Inc. Acquisition of Genetic Microsystems, Inc. by means of a Merger", executed on September 10, 1999. Excerpted pages are provided in Appendix A of this response as evidentiary support. Additionally, the Merger agreement was filed with the Securities and Exchange Commission on October 14, 1999 as

Application No.: 09/682,074

Appendix A (page 107) of Form S-4. Form S-4, as filed, is a matter of public record, and may be found at the following address on the SEC website:

<http://www.sec.gov/Archives/edgar/data/913077/0000950123-99-009310-index.html>

Additionally, an announcement of the completion of the acquisition was filed with the SEC on Form 8-K on February 11, 2000 and may be found at the following address on the SEC website:

<http://www.sec.gov/Archives/edgar/data/913077/0000891836-00-000073-index.html>

Other Amendments to Claims

The applicants also respectfully assert that Claims 2, 4-6, 9, 12, 15, 22-24, 29, and 32-34 have been amended for reasons that do not relate to the patentability of each of the claims. For example, applicants deleted the word "first" from claim 2 and added the word "second" for the purposes of clarity from the interface of amended claim 1. Also, the words "probe-feature" has been deleted and replaced with the word "probe" as the word "feature" is not necessary in the claims.

As an additional example, applicants amended claim 12 to depend from and remove the limitations that have been amended to claim 1, such as removing the words "providing a second user interface that enables user selection of the location data" and "accessing ... based, at least in part, on the user selection".

Application No.: 09/682,074


CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance. If the Examiner has any questions pertaining to this application or feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (781) 280-1522.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 01-0431.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By 
William R. McCarthy, III
Reg. No. P-55,788

Attachments

Customer No.: 22886
Legal Department
Affymetrix, Inc.
3380 Central Expressway
Santa Clara, CA 95051
Tel: 408/731-5000
Fax: 408/731-5392

Application No.: 09/682,074

Appendix A

The following 12 pages are excerpted from a merger agreement titled "Affymetrix, Inc. Acquisition of Genetic Microsystems, Inc. by means of a Merger" as evidentiary support for the assertion that Genetic Microsystems is a wholly owned subsidiary of Affymetrix, Inc.

The agreement has been filed with the Securities and Exchange Commission in its entirety and is a matter of public record.